

REMARKS

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1, 2, 3, 9, 10 and 11) drawn to a combination comprising a nucleic acid selected from SEQ ID NOs:4, 6 and 7, vectors, and host cells comprising said nucleic acid.

Group II (claim 4) drawn to a method of using a cDNA to screen a plurality of molecules to identify a ligand.

Group III (claims 5-8) drawn to a method of using a cDNA to detect differential expression in a sample.

Group IV (claims 12 and 13) drawn to a purified protein.

Group V (claim 14) drawn to a method of using a protein to screen a plurality of molecules to identify a ligand.

Group VI (claim 15) drawn to a method of using a protein to prepare an antibody.

Group VII (claims 16 and 17) drawn to an isolated antibody.

Group VIII (claims 18 and 19) drawn to a method of using an antibody to detect expression in sample.

Group IX (claim 20) drawn to a method of using an antibody to immunopurify a protein.

The Examiner has further required for each of inventions I-IX above, restriction to one of the following is also required under 35 U.S.C. 121. Therefore, election is required of one of the inventions I-VI and one of the inventions (A)-(P) (sic, C?).

(A) SEQ ID NO:4.

(B) SEQ ID NO:6.

(C) SEQ ID NO:7.

The Examiner stated further that claim 1 is drawn to a combination comprising a plurality of cDNAs having the nucleic acid sequence of SEQ ID NO:1-9. Thus this claim requires that the combination must comprise each of SEQ ID NO:1-9 as well as the complements of SEQ ID NO:1-9.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to claims 1, 2, 3, 9, 10 and 11. Applicants further elect SEQ ID NO:7 relative to the examination of these claims, again with traverse. Applicants submit that claims 4-8 of Groups II and III are methods of making and/or using the products of the claims of Group I that depend from and are limited in scope to the products of those claims and could therefore be examined together with the claims of Group I without

undue burden. Applicants further submit that the Examiner's requirement for applicants to elect a single species for examination relative to the claims of Group I is improper. The MPEP § 803.04 states that when an application contains both combination and composition of matter claims, as in claims 1 and 2 of Group I of the instant application, and as recited in examples A-C in the MPEP § 803.04:

In applications containing all three claims set forth in examples (A)-(C), the Office will require restriction of the application to ten sequences for initial examination purposes. Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed. (Emphasis added)

Applicants submit that since the combination of claim 1 contains less than ten sequences, all sequences of the combination should be examined. Applicants therefore request reconsideration of the Restriction Requirement and examination SEQ ID NOs:1-6 relative to claims 1-8 of Groups I-III. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

INCYTE CORPORATION

Date:

June 30, 2003

David G. Streeter

David G. Streeter, Ph.D.

Reg. No. 43,168

Direct Dial Telephone: (650) 845-5741

Customer No.: 27904
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886